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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/15/2005

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EXAMINER

PATEL, KANJIBHAI B

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,834	Applicant(s) GOMILA ET AL.	
	Examiner Kanji Patel	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-22 is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Applicant's amendment filed 11/21/2008 has been entered and made of record.
Claims 23-27 are added new. Claims 1-27 are currently pending in the application.

Information Disclosure Statement

2. Information disclosure statement filed 11/21/2008 has been considered by the examiner.

Claim Objections

3. In response to applicant's amendment to claims 9-10, the claim objection has been withdrawn.

Response to Arguments

4. In response to applicant's amendment and persuasive arguments, see pages 7-9 of the remarks filed 11/21/2008, with respect to the rejections of claims 1, 7, 14-15 and 18-20 under 35 USC 103, the 103 rejection of claims 1, 7, 14-15 and 18-20 has been withdrawn. However, upon further consideration, a new ground of rejection is made as below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 and 27 recite the limitations of “out of band and in band with respect to the image representative information” is vague and unclear. What is meant by “out of band and in band? What kind of band it represents is not clear. Is it a frequency band or something else?

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 and 23-27 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at 590”). While the instant claims recite a series of steps or acts to be performed, the claims neither **transform** an article nor positively tie to a **particular machine** that

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

The steps of “receiving image information that includes at least one parameter among a set of possible parameters specifying different attributes of the film grain previously in the image, selecting a model for simulating grain, simulating the film grain in accordance with the selected model and the at least one parameter and merging the simulated film grain into the image” do not impose meaningful limits on the claim’s scope, in that these steps amount to insignificant pre and post solution activity common to nearly every image processing method, and they have no impact on the “simulating the film grain” that constitutes the basic inventive concept. The “simulating the film grain and merging the simulated grain” steps could be performed manually, and does not require machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is no recitation of an external (non-data) representation of the physical object or substance, such as a visual depiction of the simulated film grain in the image.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

¹ *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Faber, Robert, A (EP 0622 000 B1---IDS).

For claim 23, Faber, Robert, A discloses a method for simulating film grain (column 3 line 55 to column 4 line 1; Figure 1) comprising the steps of."

receiving image information representative of an image (paragraph 0018-0020);
receiving film grain information that includes at least one parameter specifying at least one film grain attribute (paragraph 0021-0022); and
simulating the film grain in accordance with the at least one parameter (paragraph 0022; column 3 line 55 to column 4 line 1).

For claim 26, Faber, Robert, A discloses a method for communicating image information and film grain information comprising the step of transmitting the film grain information out-of band with respect to the image representative information (Figure 1; paragraphs 0016-0022).

For claim 27, Faber, Robert, a method for communicating image information and film grain information comprising the step of transmitting the film grain information in-band with respect to the image representative information (Figure 1; paragraphs 0016-0022).

Allowable Subject Matter

7. The following is a statement of reasons for the indication of allowable subject matter:

Claims 18-22 are allowed.

In response to applicant's amendment and persuasive arguments, see pages 7-9 of the remarks filed 11/21/2008, with respect to the rejections of claims 18-20 under 35 USC 103, the 103 rejection of claims 18-20 has been withdrawn. Therefore claims 18-22 are allowed now.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kanji Patel whose telephone number is (571) 272-7454. The examiner can normally be reached on Monday to Thursday from 8 a.m. to 6:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh, Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ Kanji Patel/

Primary Examiner, Art Unit 2624